



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Saha *et al.*

Attorney Docket No.
61169.00043 (P-2944)

Application No.: 10/728,496

Group Art Unit: 2624

Filed: December 5, 2003

Examiner: Bernard Krasnic

Title: Method for Measuring Structural Thickness from Low-Resolution Digital Images

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Declaration of Bryon Gomberg under 37 C.F.R. §1.131

I, Bryon Gomberg declare that:

1. I am a named and true inventor of U.S. Patent Appl. 10/ 728,496, filed December 5, 2003, claiming an effective filing date of December 5, 2002, when U.S. Provisional Application No. 60/431,129 was filed, the content of which was incorporated into the present application in its entirety.
2. It is my understanding that the United States is the only country in the world that has a "first to invent" law. All other countries use "first to file" laws where the first party to file a patent application on a new invention will generally be the one that gets the patent. In the United States the assertion that one is "first to invent" must be supported by solid, verifiable records of the date of invention, followed by diligent pursuit. Verifiable records may be by: 1) records that are understood and witnessed by unbiased third parties that can and will testify about them in court, 2) contemporaneously prepared (or collected) business records that are believable and that you (or their preparers) can believably swear by, and 3) records that are held by an unimpeachable source (such as the now-ended disclosure program at the U.S. PTO).

3. The Patent Examiner has cited my 2002 Doctoral Dissertation ("In vivo magnetic resonance based virtual bone biopsy") at the University of Pennsylvania as prior art under §103(a) against the patentability of certain claims of our invention.
4. As I further understand it, 35 U.S.C. §103(a) states that "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title." In turning to 35 U.S.C. §102(a), an Applicant is entitled to a patent unless the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
5. However, 35 U.S.C. §103, would not apply to my invention as compared to my Dissertation for the purpose of establishing a priority date since the cited work in my thesis was done in collaboration with my co-inventors, and clearly it could not have been included in my thesis, unless or until, we had previously conceived of the invention prior to the cited thesis publication date in May 2002. Moreover, since the 2002 publication date is less than 1 year from the effective December 5, 2002 filing date of our patent application, the cited prior art is not effective prior art. The cited Dissertation did not anticipate the present patent application since it actually was part of the subject invention. Consequently, my own Dissertation is not proper "prior" art against this invention on which I am a named inventor.
6. Claims 22 and 24 of our invention are not obvious over my Dissertation, since in that Dissertation I disclosed parts of our invention, diligently reduced to practice, and the subject of provisional application 60/431,129, establishing the effective filing date of the present utility application.
7. I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: October, 2008



Bryon Gomberg